

Appln No. 09/650,482
Amdt date September 11, 2008
Reply to Final Office action of June 11, 2008

REMARKS/ARGUMENTS

In the Office action mailed June 11, 2008, claims 1-10 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,737,539 to Edelson et al. ("Edelson"), claims 11-13 and 18 are rejected under 35 U.S.C. section 103(a) as being unpatentable over Edelson in view of the On-line Medical Dictionary, claims 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edelson in view of the On-line Medical Dictionary and further in view of U.S. Patent No. 5,845,255 to Mayaud ("Mayaud"), claims 21-23 are rejected under 35 U.S.C. 103(a) as unpatentable over Edelson in view of Official Notice, and claims 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edelson and Official Notice and further in view of U.S. Patent No. 5,758,095 to Albaum et al. The Examiner is thanked for attention to the application.

Claims 1 and 16 are now amended to more fully elucidate matters that were believed to be already present in those claims.

Claim 1 specifies "a plurality of formulary records, the formulary records comprising chemical composition and properties of each of a plurality of medications." The Office action admits that Edelson does not disclose the formulary records comprising chemical composition and properties of each of a plurality of medications as recited in claim 1. Office action, p. 3.

Claim 1, as amended, specifies that "the service center server is configured to supply the pharmacy server at least one of the plurality of formulary records comprising chemical composition and properties for at least one of the orders for medication upon request by the at least one pharmacy client system when at the least one of the orders for medication is processed." As Edelson does not disclose "formulary records comprising chemical composition and properties", Edelson a priori can not disclose a service center server "configured to supply the pharmacy server at least one of the plurality of formulary records comprising chemical composition and properties for at least one of the orders for medication upon request by the at

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least one pharmacy client system when at the least one of the orders for medication is processed" as recited in claim 1

The Office action, nevertheless, states that "the difference is only found in the non-functional descriptive material....Thus, this material will not distinguish the claimed invention from the prior art in terms of patentability...." Office action, p.3. While it is not believed that discussion of descriptive material is appropriate in the present case, nonetheless the analysis provided in the Office action itself provides sufficient reason to withdraw the rejection of claim 1, as amended.

The Office action states that functional descriptive material consists of data structures, and provides a definition of data structures that includes a logical relationship among data elements, designed to support specific data manipulation functions.

In claim 1, the formulary records comprise chemical composition and properties of each of a plurality of medications. Moreover, the service center server is configured to supply at least one of the plurality of formulary records comprising chemical composition and properties for at least one of the orders for medication. The formulary records comprising chemical composition and properties therefore have a logical relationship with the orders for medication, which supports specific functions of the server. Accordingly, in accordance with the Office action, the formulary records comprising chemical composition and properties of each of a plurality of medications is not non-functional descriptive material, but would instead be classified as functional descriptive material.

Accordingly, claim 1 is allowable, as are dependent claims 2-15.

Claim 16, as amended, specifies "a global database including a plurality of formulary records, the formulary records comprising chemical composition and properties of each of a plurality of medications" and a service center server "configured to supply the pharmacy server at least one of the plurality of formulary records comprising chemical composition and properties for at least one of the orders for medication."

In rejecting claim 16, the Office action repeats text from the rejection of claim 1 that Edelson does not disclose "formulary records comprising chemical composition and properties"

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(Office action, p. 9) and “the difference is only found in the non-functional descriptive material...Thus, this material will not distinguish the claimed invention from the prior art in terms of patentability....” (Office action, p. 9).

Considering the discussion above regarding claim 1, Claim 16 is allowable, as are dependent claims 17-27.

In addition, regarding claim 16 (and other claims), the Office action states that “The ‘wherein’ clause merely states the result of a limitation in the claim and is therefore given little patentable weight”, and cites to several cases. It is not believed the cited cases support the conclusion reached by the Office action. Moreover, considering for example the “wherein” clauses of claim 16, it does not appear that the “wherein” clauses merely state a result of a limitation in the claim. If the Examiner persists in giving little patentable weight to “wherein” clauses, it is respectfully requested that the next Office action specify the other limitations in the claim for which the “wherein” clauses merely state a result.

Without attempting to be comprehensive, it is also noted that, at the portions cited by the Office action, Edelson does not appear to disclose what is attributed to Edelson. For example, claim 8 specifies that “modification to the ingredients of the medication include changes to amounts of caloric content in the medication.” The Office action states that “With respect to claim 8, Edelson teaches, wherein updates to the modification to the ingredients of the medication include changes to amounts of caloric content in the medication (col. 32, lines 54-59).” Office action, p. 5.

Edelson at col. 32, lines 54-59, however, states “Other suitable information data retrieval and updating systems will be apparent to those skilled in the art and can be linked to the system of the present invention to provide allergy and interaction alerts, formulary changes, new drug approvals, and to lock out or warn against the prescribing of inappropriate or recalled drugs.” In this section of Edelson, there appears no mention of caloric content. Accordingly, claim 8 is further allowable.

The same portion of Edelson is cited with respect to claim 9 for disclosing modification to the ingredients of the medication including changes to amounts and preferences of electrolytes

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in the medication. Again, in the cited section of Edelson, provide above, there appears no mention of electrolytes. Accordingly, claim 9 is further allowable.

Turning to the taking of Official Notice, "Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While "official notice" may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113." MPEP 2144.03. "Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*. 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961))."

With respect to claim 21, the Office action states "Official Notice is taken that it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the order maintenance unit configured to generate medication specific labels for the medication to have a prescription delivery system to generate the invoice and label and other documentation prior to delivering the medication to the patient." Office action, p. 11. As an initial matter, it does not appear that a conclusion of obviousness in itself is incapable of being capable of instant and unquestionable demonstration as being well-known, or to defy dispute. As the Office action, however, states that Edelson fails to teach an order maintenance unit configured to generate medication specific labels for the medication, and claim 21 specifies such, it may be assumed that the Office action is instead taking Official notice of an order maintenance unit configured to generate medication specific labels for the medication. However, claim 1 specifies both medication specific labels, and that the order maintenance unit is configured to generate the medication specific labels, as opposed to some other unit. That an order maintenance unit would be so configured does not appear to be capable of such instant and unquestionable demonstration as to defy dispute. Accordingly, the Examiner is requested to provide documentary evidence supporting the rejection if the rejection is to be maintained.

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With respect to claim 22, the Office action states "Official Notice is taken that it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the medication specific labels for the medication include information about a refractive index of the intravenous solution to have the information regarding the refractive index since the refractive index increases with the atomic number of constituent atoms in the intravenous solution. Again, it appears that the Office action is inappropriately taking Official Notice of a conclusion. Further, that the refractive index may increase with the atomic number of constituent atoms in a solution also does not appear, standing alone to provide reason to include refractive index information on a medication specific label. Accordingly, the Examiner is requested to provide documentary evidence supporting the rejection if the rejection is to be maintained.

With respect to claim 23, the Office action takes Official Notice regarding aspects of the claim, but it appears that text regarding the Official Notice is missing text, and it is not clear as to what fact or facts Official Notice is being taken. Moreover, it appears that the basis of Official Notice is that a flame photometer would be useful in medical conditions relating to the loss of potassium. However, the relationship between this basis and either the rejection of claim 23 or of what Official Notice is unclear. Accordingly, the Examiner is requested to provide documentary evidence supporting the rejection if the rejection is to be maintained.

With respect to claim 26, the Office action states "Official Notice is taken that it would have been obvious to one having ordinary skill in the art at the time the invention was made to have substances that dissociates into two or more ions, to some extent, in water." It may be agreed that there are substances that disassociate into at least two ions, to some extent, in water. The relationship of such a fact to the rejection of claim 26, however, is not apparent from the Office action, and therefore the Examiner is requested provide documentary evidence or further reasoning supporting the rejection if the rejection is to be maintained.

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Accordingly, the application is in condition for allowance, and allowance of same is respectfully requested.

Respectfully submitted,
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